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PATENT

REMARKS

Claims 1 to 26 are pending in this patent application.

Claims 1 to 6, 9 to 13, and 18 to 25 have been amended.

Claims 1 to 6 and 18 to 25 have been amended to remove non-elected subject matter in view of the election/restriction requirement dated November 24, 2004, without prejudice to their presentation in a later-filed divisional patent application.

In view of the foregoing amendments and the following remarks, reconsideration and withdrawal of the rejections are respectfully requested.

Discussion of the Double Patenting Rejections

Claims 1 to 8 and 15 to 26 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being obvious in view of the claims of commonly owned U.S. Patent No. 6,686,395 ("the 395 patent") and commonly owned U.S. Patent No. 6,531,495 ("the 495 patent"). Applicants respectfully traverse this rejection.

Applicants have herein amended the claims to remove the recitations SO₂R(10) and COR(11) from the definition of R(1). Applicants' representative, the undersigned, discussed this amendment with Examiner Desai telephonically on August 8, 2005, who indicated that such amendment would overcome the rejection. Accordingly, in view of the foregoing amendments, the double patenting rejection in view of the 395 patent is moot.

However, although 35 U.S.C. § 121 authorized the Commissioner to restrict the claims in a patent to a single invention, it also prohibits the use of a patent that has issued on an application in which a restriction has been made as a reference against any later-filed divisional application

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if (1) the Office required the restriction; and (2) the divisional application is filed before the issuance of the patent.

The present patent application is a divisional of application No. 10/252,385, filed on September 24, 2002, now the 395 patent, which, in turn, is a divisional of application No. 09/698,078, filed on October 30, 2000, now the 495 patent. Attached hereto is (1) the restriction requirement issued during prosecution of the 495 patent (Exhibit A), and (2) the restriction requirement issued during prosecution of the 395 patent (Exhibit B). As is evident from Exhibits A and B (as well as from the Disclosures of the 395 and 495 patents), the present claims are pending because they were not elected in response to restriction requirements issued during the prosecution of the 395 and 495 patents. Accordingly, use of either the 395 or the 495 patent is improper under 35 U.S.C. § 121 and reconsideration and withdrawal of the rejections are requested respectfully.

Discussion of the Rejection of Under 35 U.S.C. § 112, First Paragraph

Claims 9 to 14 and 26 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement. Applicants traverse this rejection because one skilled in the art having read the present specification and claims would be able to make and use the present inventions with respect to the "prophylaxis" of the claimed conditions, without engaging in undue experimentation. Although Applicants disagree respectfully with this rejection, Applicants have nonetheless amended the claims, without prejudice, to remove the term "prophylaxis" from claims 9 to 14 in order to further prosecution of this patent application.

Regarding claim 26, which defines a method for preventing the re-occurrence of arrhythmias, Applicants submit respectfully that one skilled in the art would be able to practice

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the method of claim 26 without undue experimentation. In this regard, one of ordinary skill in the art to which the present invention is directed knows that inhibition of Kv1.5 represents an effective method for prolonging the atrial action potential and, thus, for preventing atrial arrhythmias. Applicants' specification at, for example, pages 95 to 97, illustrate the Kv1.5 inhibitory effects of the compounds of the claimed invention. Thus, Applicants' specification provides an enabling disclosure that is commensurate to the scope of the invention as defined by claim 26. Applicants note that a similar claim was issued as claim 19 in the 395 patent. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Information Disclosure Statement

The Action indicates that the IDS filed "10/03 fails to comply with 37 C.F.R. 1.98(a)(2)" for allegedly lacking a legible copy of the following three references listed thereon:

- 1) Volker Brandmeier et al., "Antiparallel β -Sheet Conformation in Cyclopeptides Containing a Pseudo-amino Acid with a Biphenyl Moiety," *Helvetica Chimica Acta* - Vol. 77, pps. 70-85 (1994) ("the Brandmeier reference");
- 2) Lullman, H. et al., *Pharmakologie und Toxikologie*, 1999, Georg Thieme Verlag, Stuttgart XP002159084, pps. 151-153 ("the Lullman reference"); and
- 3) Caplus AN 2001:608248 English Abstract Chemstar Product list RN # 328284, May 16, 2001 ("the Caplus reference").

The Action requested copies of the above references apparently because the references were not available electronically. In an effort to assist the Examiner, Applicants attorney searched the files and found *two* of the references, the Brandmeier reference and the Lullman reference. Accordingly, Applicants are filing herewith a Supplemental IDS listing all three

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references, but providing only the Brandmeier reference and the Lullman reference. With respect to the Lullman reference, the Supplemental IDS also includes a concise explanation as to the relevance of the reference pursuant to 37 C.F.R. § 1.98(a)(3)(i) because the reference is a German-language reference.

With respect to the Caplus reference, however, Applicants wish to make several comments. First, Applicants note that the publication date of the Calpus reference appears to be May 16, 2001, which is *after* the October 30, 2000 priority date of the present application, *i.e.*, the filing date of the application that became the 495 patent. Thus, the Caplus reference does not appear to qualify as prior art against the present claims. This is confirmed by the present Examiner in her Notice of Allowance dated August 16, 2002, in the application that became the 495 patent (U.S. application No. 09/698,078) (*see* Reasons for Allowance).

Next, Applicants note that the present Examiner first identified the Caplus reference as evidenced by the face of the 395 and the 495 patent. The reference does not appear to have been forwarded to the Applicants. Finally, Applicants request respectfully that the Examiner check the above citation to the Caplus reference because such reference could not be identified during several attempts to provide the Examiner with a copy of the reference.

If Applicants can provide additional assistance, they would be pleased to do so.

Miscellaneous

Applicants request that the referenced docket number of the present application be changed from "02481.1687-03" to —DEAV1999/L060 US NP2—. Applicants thank the Examiner for her attention to this detail.

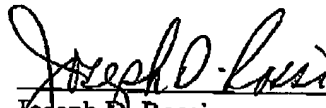
DEAV1999/L060 US NP 2**PATENT****Conclusion**

The foregoing is submitted as a full and complete response to the Action mailed on May 9, 2005, and the allowance of all claims is respectfully requested. If there are any issues that can be resolved by a telephone conference or an Examiner's amendment, the Examiner is invited to call the undersigned attorney at (908) 231-3410.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. 18-1982 in the name of Aventis Pharmaceuticals Inc.

Respectfully submitted,

Dated: August 9, 2005



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